

**Santamauro, Jon**

**From:** mprotsik@patentvalley.com  
**Sent:** Monday, April 30, 2001 4:31 PM  
**To:** scpcomments@uspto.gov  
**Subject:** International Effort to Harmonize the Substantive Requirements of Patent Laws

From:

Mark Protsik, Patent Agent  
Law Offices of Thomas Schneck  
PO Box 2-E  
San Jose CA 95109-0005  
(408)297-9733 voice  
(408)297-9748 fax  
mark@patentvalley.com

To:

Director of the United States Patent and Trademark Office  
Box 4  
Washington DC 20231  
Attn: Mr. Jon P Santamauro

The following comments represent my own views.

The distinction between the Treaty and the Regulations is blurred in the present draft by the presence in the Regulations of subject matter that is substantive in nature, rather than implementation. In particular, in the upcoming discussions, consideration should be given to moving some or all of the following text into treaty articles:

Rule 4(2)

Rule 6 (definition of public availability and accessibility)

Rule 7 (prior art effect of certain applications)

Rule 8(ii) (considerations for adequate disclosure re enablement)

Rule 11(1), (2) and (3) (claim interpretation, esp. doctrine of equivalents, prosecution history estoppel)

Rules 13 and 14 (definition/determination of novelty and obviousness, esp need for enabling disclosure for novelty (Rule 13(3)) and standards for obviousness (only minimally recited in Rule 14(2) of current draft).

The treaty should spell out clearly what is the standard for an enabling disclosure, utility, novelty, obviousness, and what basic criteria are to be used in making a determination of these requirements in order to achieve a true harmony of patent laws. For example, the USPTO, EPO and JPO all evaluate patent applications in terms of obviousness or inventive step, but with widely varying results. Either alternative version of Article 18 in the present draft treaty merely gives lipservice to harmony, stating a generality of little substance, without going to the real differences in practice that result in different judgements on obviousness.

Participants in the conference would benefit by going through both the EPO Guidelines, C(IV)(9), and MPEP 2141-2146 in depth to discover the how the real differences in approach to the obviousness issue lead to different outcomes in the respective patent offices, and then draft treaty articles of real substance to harmonize the outcomes.

Sincerely,  
Mark Protsik